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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/259,991 03/01/99 MAHNE

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EXAMINER

TM02/1220

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SYNTHETICALLY

ART UNIT

PAPER NUMBER

2132

DATE MAILED:

12/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/259,991

Applicant(s)

MAHNE ET AL.

Examiner

Matthew B Smithers

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-19, 22, 24-26, 33, 34, 38, 39, 43 and 45 is/are rejected.
- 7) ☒ Claim(s) 13, 14, 20, 21, 27-32, 35-37, 40-42, 44 and 46 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 26 is objected to because of the following informalities: Claim 26 depends from itself. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-12, 15-19, 22, 24-26, 33-34, 38-39, 43 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 5,796,825 granted to McDonnal et al.

Regarding claim 1, the patent to McDonnal meets the claimed limitations as follows:

“A method of encrypting an electronic file in an application program running in a suitable environment required for operating the program, comprising the steps of:

issuing a change document command to act upon the file;

intercepting the change document command;” see column 27, lines 48-52 (. .

. additionally, file-WRITE requests (change document) can be intercepted . . .).

**“acquiring an encryption key value;
encrypting the file using the encryption key value to create an encrypted
file;
and completing the change document command by performing the change
document command upon the encrypted file instead of the file.”** see column 29,
lines 5-26.

Regarding claim 2, the patent to McDonnal meets the claimed limitations as
follows:

**“A method as recited in claim 1, wherein step c) further comprises the steps of
determining if the file should be encrypted, and if not, then skipping step d), and
if so, then:**

**retrieving a encryption key name associated with the file;
and retrieving the encryption key value associated with the encryption key
name.”** see column 27, lines 46-55 and column 29, lines 5-26.

Regarding claim 3, the patent to McDonnal meets the claimed limitations as
follows:

**“A method as recited in claim 2, wherein there are plural encryption key
values and at least one encryption key value associated with a user.”** see column
29, lines 5-26.

Regarding claim 4, the patent to McDonnal meets the claimed limitations as
follows:

“A method as recited in claim 3, comprising the further steps of:

requiring the user to submit to an access authentication step;
and if the access authentication step does not authenticate the user, then skipping steps c) and d), but if the access authentication step does authenticate the user, then retrieving the encryption key value associated with the encryption key name and the user.” see Figure 2B, element 226 and column 18, line 59 to column 19, line 7.

Regarding claim 5, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 1, wherein steps steps c) and d) further comprise the steps of:

selecting an algorithm to use with the file from one of a plurality of encryption algorithms;

selecting an encryption key with a key value;

generating a file identifier from the encryption key, an algorithm identifier associated with the algorithm and a data identifier associated with the file;

adding the file identifier to the file;

and using the key value and the algorithm to encrypt the file.” see column 8, lines 20-63; column 18, lines 14-56 and column 29, lines 5-19.

Regarding claim 6, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 5, comprising the further steps of:

selecting the file from within the contents of a second file that is larger than the file.” see column 10, lines 55-64.

Regarding claim 7, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 6, comprising the further steps of:

creating a third file from the second file wherein the third file contains the encrypted file and the portion of the second file that does not include the file.”
see column 10, lines 65-67.

Regarding claim 8, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 7, wherein the encrypted file is located in a container.” see column 10, lines 60-64.

Regarding claim 9, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 5, wherein the algorithm is selected from the plurality of encryption algorithms according to a preselected criteria.” see column 8, lines 49-63 (. . . Recryption Rule File . . .).

Regarding claim 10, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 5, wherein the algorithm is selected from the plurality of encryption algorithms according to a preselected algorithm.” see column 8, lines 20-40 and column 29, lines 5-11.

Regarding claim 11, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 5, wherein the file identifier is inserted into the file according to a preselected criteria.” see column 18, lines 29-37.

Regarding claim 12, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 5, wherein the file identifier is inserted into the file according to a preselected algorithm.” see column 18, lines 8-19.

Regarding claim 15, the patent to McDonnal meets the claimed limitations as follows:

“A method of decrypting an electronic file that is to be opened in an application program running in a suitable environment required for operating the program, comprising the steps of:

issuing an open document command to act upon the file;” see column 14, lines 35-38.

“intercepting the open document command;” see column 6, lines 25-29 and column 14, lines 49-51.

“retrieving a decryption key value;

decrypting the file using the decryption key value to create an unencrypted file;” see column 20, lines 30-39.

“and completing the open document command by performing the open document command upon the unencrypted file instead of the file.” see column 20, lines 46-54.

Regarding claim 16, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 15, wherein step c) further comprises the steps of determining if the file should be decrypted, and if not, then skipping step d), and if so, then:

retrieving a decryption key name associated with the file;

and retrieving the decryption key value associated with the decryption key name.” see column 16, line 42 to column 17, line 22; Figure 2B, element 220 and column 20, lines 30-39.

Regarding claim 17, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 16, wherein there are plural decryption key values and at least one decryption key value associated with a user.” see column 20, lines 30-39.

Regarding claim 18, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 17, comprising the further steps of:

requiring the user to submit to an access authentication step;

and if the access authentication step does not authenticate the user, then skipping steps c) and d), but if the access authentication step does authenticate the user, then retrieving the decryption key value associated with the decryption key name and the user.” see Figure 2B, element 226 and column 18, line 59 to column 19, line 7.

Regarding claim 19, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 15, wherein steps steps c) and d) further comprise the steps of:

selecting an algorithm to use with the file from one of a plurality of encryption algorithms;

inputting a decryption key with a key value;

validating the decryption key value with the key value associated with a file identifier;

and using the key value and the algorithm to decrypt the file.” see column 8, lines 20-63; column 18, lines 14-56 and column 29, lines 5-19.

Regarding claim 22, the patent to McDonnal meets the claimed limitations as follows:

“A method for encrypting and decrypting a file with one of a plurality of encryption algorithms, comprising the steps of:

selecting an algorithm to use with the file from one of a plurality of encryption algorithms;

selecting an encryption key with a key value;
generating a file identifier from the encryption key, an algorithm identifier associated with the algorithm and a data identifier associated with the file;
adding the file identifier to the file;
and using the key value and the algorithm to encrypt the file and generate an encrypted file;
inputting a decryption key with a key value;
validating the decryption key value with the key value associated with a file identifier;
and using the key value and the algorithm to decrypt the file.” see column 8, lines 20-63; column 18, lines 14-56 and column 29, lines 5-19.

Regarding claim 24, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 22, comprising the further steps of:

selecting the file from within the contents of a second file that is larger than the file.” see column 10, lines 55-64.

Regarding claim 25, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 24, wherein the encrypted file is located in a container.” see column 10, lines 60-64.

Regarding claim 26, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 26, comprising the further steps of:

creating a third file from the second file wherein the third file contains the encrypted file and the portion of the second file that does not include the file.”

see column 10, lines 65-67.

Regarding claim 33, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 22, wherein the algorithm is selected from the plurality of encryption algorithms according to a preselected criteria.” see column 8, lines 49-63 (. . . Recryption Rule File . . .).

Regarding claim 34, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 22, wherein the algorithm is selected from the plurality of encryption algorithms according to a preselected algorithm.” see column 8, lines 20-40 and column 29, lines 5-11.

Regarding claim 38, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 22, wherein the file identifier is inserted into the file according to a preselected criteria.” see column 18, lines 29-37.

Regarding claim 39, the patent to McDonnal meets the claimed limitations as follows:

“A method as recited in claim 22, wherein the file identifier is inserted into the file according to a preselected algorithm.” see column 18, lines 8-19.

Regarding claim 43, the patent to McDonnal meets the claimed limitations as follows:

“A method for encrypting a file with one of a plurality of encryption algorithms comprising the further step of:

selecting an algorithm to use with the file from the plurality of encryption algorithms;

selecting an encryption key with a key value;

generating a file identifier from the encryption key, an algorithm identifier associated with the algorithm and a data identifier associated with the file;

adding the file identifier to the file;

and using the key value and the algorithm to encrypt the file and generate an encrypted file.” see column 8, lines 20-63; column 18, lines 14-56 and column 29, lines 5-19.

Regarding claim 45, the patent to McDonnal meets the claimed limitations as follows:

“A method for decrypting an encrypted file with one of a plurality of encryption algorithms, comprising the steps of:

selecting an algorithm to use with the file from the plurality of encryption algorithms;

inputting a decryption key with a decryption key value;

validating the decryption key value with the key value associated with a file identifier that was added to a file during an encryption process that created the encrypted file;

and using the key value and the algorithm to decrypt the file.” see column 8, lines 20-63; column 18, lines 14-56 and column 29, lines 5-19.

Allowable Subject Matter

Claims 13-14, 20-21, 23, 27-32, 35-37, 40-42, 44 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Jones (5,289,540) discloses a system for protecting computer files.

B. Pebley et al (6,154,840) discloses a system for transferring encrypted documents across a network.

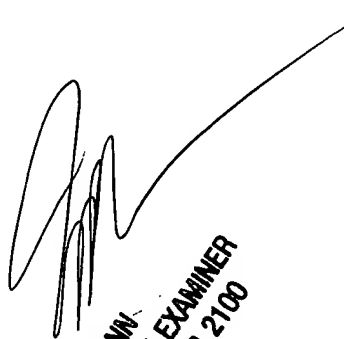
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B Smithers whose telephone number is (703) 308-9293. The examiner can normally be reached on M-Th (7:30-6:00) Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod R Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 305-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Matthew Smithers
December 17, 2000



TOD SWANN
SUPERVISORY PATENT EXAMINER
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